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COMMENTS: Please file the attached Reply Brief in Application 09/014,076
(Docket: D-1056 DIV3)

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September 26, 2008

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3653
Patent Examiner Michael E. Butler

Re: Application No.: 09/014,076
Confirmation No.: 4092
Applicants: Max Fedor, et al.
Title: Method For Tracking And Dispensing
Medical Items
Docket No.: D-1056 DIV3

Sir:

Please find enclosed a Reply Brief for filing in response to the Supplemental Examiner's Answer dated July 29, 2008.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Reply Brief and any other fee due to Deposit Account 10-0637.

Very truly yours,

A handwritten signature of Ralph E. Jocke in black ink.

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.6(d)

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D-1056 DIV3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal Nos.: 2005-1136)	
2005-0064)	
2003-1769)	
)	
Appellants: Max Fedor, et al.)	Art Unit 3653
)	
Application No.: 09/014,076)	
)	
Confirmation No.: 4092)	Patent Examiner
)	Michael E. Butler
Filed: January 27, 1998)	
)	
Title: Method For Tracking And)	
Dispensing Medical Items)	

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PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS

Sir:

The Appellants hereby submit their 3rd Reply Brief concerning the Application. This Reply Brief is in response to the Supplemental Examiner's Answer dated July 29, 2008. The Supplemental Examiner's Answer is the result of several granted petitions and several Remand/Orders to the examiner from the Board of Patent Appeals and Interferences ("Board"). Appellants' Appeal Brief was filed March 7, 2001 pursuant to 37 C.F.R. § 1.192.

- 1 -

STATUS OF CLAIMS

Claims 38-53 are pending in the Application.

Claims rejected: 38-53

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: 1-37

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 48-53 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Pearson (US 5,292,029). Hereinafter "Pearson '029".
- 2). Whether claims 38-41, 43, and 45-53 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Pearson (US 5,562,232). Hereinafter "Pearson '232".
- 3). Whether claims 39-43, 45-47, and 49-53 are unpatentable under 35 U.S.C. § 103(a) over Pearson '232 in view of Meador (US 5,883,806).
- 4). Whether claims 38-53 are unpatentable under 35 U.S.C. § 103(a) over Pearson '232 in view of Blechl (US 5,377,864).
- 5). Whether claims 48-53 are unpatentable under 35 U.S.C. § 103(a) over Halvorson (US 4,847,764).

ARGUMENT

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SEP 29 2008**The new grounds of rejection in the Supplemental Examiner's Answer**

As best understood, the "Grounds of Rejection" section set forth (at pages 3-11) in the Supplemental Examiner's Answer dated July 29, 2008 corresponds (almost verbatim) to the "Grounds of Rejection" section previously presented in the Examiner's Answer dated February 13, 2003 (at pages 5-15). Likewise, the respective "Response to Argument" sections of these Answers similarly correspond. As best understood, the only issue difference between these Answers involves the 37 C.F.R. § 1.131 declaration issue (which will be discussed in more detail below). Thus, Appellants respectfully submit almost all of the issues set forth in the Supplemental Examiner's Answer have already been fully addressed in their previous Appeal Brief (filed March 7, 2001 pursuant to 37 C.F.R. § 1.192) and the Reply Briefs filed in association therewith. Therefore, please note Appellants' previous arguments (in their previously filed Appeal Brief and Reply Briefs) regarding these issues of record.

Appellants respectfully submit that their previous Appeal Brief filed pursuant to 37 C.F.R. § 1.192, their Reply Briefs associated therewith, and their arguments therein are already part of the appeal record and will be considered by the Board. That is, Appellants have the understanding that their previously filed arguments do not need to be repeated herein. However, *if* for some reason Appellants' previously filed arguments are not viewed by the Office as already being entitled to consideration by the Board (and need to be repeated herein), *then* they are herein incorporated by reference in their entirety for purpose of said Board consideration.

Appellants also have the understanding that the prior "Grouping of Claims" matter (in the Examiner's Answer dated February 13, 2003) is no longer an issue.

The 37 C.F.R. § 1.131 declaration issue

A first 37 C.F.R. § 1.131 declaration was filed August 30, 2000. In the Office Action dated May 3, 2006, the Office invited Appellants to file a "new declaration" under 37 C.F.R. § 1.131. Thus, a new (second) 37 C.F.R. § 1.131 declaration was filed May 19, 2006.

The Office Action dated May 24, 2007 "acknowledged" Appellants' "substitution" of the new declaration for the withdrawn first declaration. The Supplemental Examiner's Answer, in the "131 Affidavit" section, also refers to the new declaration. For example, this section (at page 11) states "Applicant has *again* . . . as a sole inventor" (in reference to the new declaration). Thus, Appellants have the understanding that the declaration has been entered into the record.

Both the Office Action dated May 24, 2007 and the Supplemental Examiner's Answer inferred that the new declaration was insufficient to overcome rejections. The reason given in the Supplemental Examiner's Answer (in the "131 Affidavit" section) for the alleged new declaration insufficiency is because the new declaration "is not accepted per applicant's failure to identify the proper inventors in the affidavit" with regard to the prior Requirement for information pursuant to 37 C.F.R. § 1.105. Appellants respectfully submit that the reason given is without basis because acceptance of the new declaration is an issue that is not dependent on the prior 37 C.F.R. § 1.105 Requirement issue. As evidenced by the record, the Requirement is no longer an issue following the petition grant dated May 8, 2008. The Office itself stated (in granting Appellants' petition) that Appellants' "response to the Requirement was *complete* and responsive". Thus, the examiner's attempt to base the effectiveness of the new declaration on a prior requirement that has been completely fulfilled is legally improper.

For reasons previously discussed in the record, Appellants respectfully submit that the new declaration is sufficient to disqualify Pearson '232 (and also Meador) as prior art to the recited subject matter of claims 38 and 48. The declaration is permitted to be signed by only the inventor of the subject matter of claims 38 and 48. 37 C.F.R. § 1.131 permits such a declaration to be signed by less than all of the inventors.

The applicable legal standard for "obviousness" has not been met by the Office

For reasons previously discussed in the record, the Office has not made a *prima facie* showing of obviousness. Even in cases where the Office has made a *prima facie* showing of obviousness, a rejection cannot be properly made unless there is a requisite showing that it would be obvious to one having ordinary skill in the art to combine the features and relationships to produce the invention as claimed. In accordance with the dictates of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the determination as to whether there is a reason to combine features of prior art reference(s) must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,
- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

Based on these required tests the claims should further be allowed.

The Office fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination

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and resolve the level of ordinary skill in the pertinent art at the time that the invention was made.

It is respectfully submitted that the Office has not made such a full determination.


The rejections are not based on the opinion of one of ordinary skill in the art

The record shows that the reasons for modifying reference features in the rejections is based on the opinion of the examiner. However, the record has not established the examiner to be a person of ordinary skill in the art. Thus, it must be concluded that the basis for combining reference features in the rejections is *not* based on the opinion of a person of ordinary skill in the art. For this further reason, the rejections are respectfully submitted to be incorrect and should be reversed.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. The Office has not established a *prima facie* case of obviousness. Furthermore, the record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the recited invention. Appellants' claims patentably distinguish over the applied references. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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